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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/208,814 | 12/09/1998 | R. PADMANABHA RAO | 939V-310-1-1 | 8650 |

7590 04/24/2002

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EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/208,814

Applicant(s)

RAO

Examiner

Son P Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-62 and 65-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-62 and 65-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. Claims 60 - 62 and 65 – 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable Rao (U.S. 5,940,738) in view of McNamara (US 4,533,948).

Regarding claim 60, Rao (US 5,940,738) recites a digital information distribution system comprising:

a digital information stream server comprising:

means for storing a digital information stream of predetermined duration;

network adaptation means for transmitting digital information onto a first communication network on a predetermined channel;

request receiving means for receiving requests for the digital information stream from the first communication network;

scheduling means for directing the digital information stream to the network adaptation

means for transmission over the first communication network on the predetermined channel at a predetermined time, if a request for the digital information stream is

received by the request receiving means; and

opportunistic programming means for directing digital information to the network

adaptation means for transmitting over the first communication network only if the digital

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information stream is not being transmitted (see col. 25, line 1 – col. 26, line 7).

^{claim 60 of}
However, [^]Rao (US 5,940,738) does not explicitly disclose a “network interface” comprising:

request receiving means for receiving request originally for the subscriber units;
and

request relaying means for relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server; and

means for relaying the digital information stream from the “first communication network” to the requesting ones of the privileged subscriber units via the “second communication network.”

McNamara discloses a CATV communication system that reads on the “network interface” being claimed (see col. 1, line 52 – col. 2, line 19). The limitation regarding “privileged” and “non-privileged” subscribers reads on the authorized and non-authorized subscribers in McNamara. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ^{claim 60 of} [^]Rao (US 5,940,738) with a “network interface” as taught by McNamara for the well-known benefit of reduce bandwidth so that increase efficiency of transferring programs to subscribe units in communication system. It is obvious to send only authorized subscribers to the headend.

Regarding claim 61, Rao recites the scheduling in the rejection of claim 60 further comprising means for:

if a request for the digital information stream is received prior to a predetermined time, initiating transmission of the digital information stream starting at a beginning of the digital information stream over the predetermined channel at the predetermined time; and

if the request for the digital information stream is received after the predetermined time, initiating transmission of the digital information stream at a point in the digital information stream determined relative to the predetermined time so that the digital information stream ends the predetermined duration after the predetermined time (see col. 24, lines 53-67).

Regarding claim 62, Rao recites the "first communication network" is a hierarchical network (see col. 24, lines 1-4).

Regarding claim 65, Rao recites the opportunistic programming means transmits digital information via the channel only upon request of a subscriber unit when the digital information stream is not being transmitted (see col. 26, lines 9-12).

Regarding claim 66, Rao recites a system as discussed in the rejection of claim 60. However, Rao does not recite the opportunistic programming means transmits digital information via the channel whenever the digital information stream is not being transmitted. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rao with a well-known technique of

transmitting digital information via the channel whenever the digital information stream is not being transmitted in order to give priority to privileged subscriber and avoid interfering of program transmission.

Regarding claim 67, Rao recites the system as discussed in the rejection of claim 60. Rao does not recite the digital information transmitted by the opportunistic programming means comprises an alternative video program. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Rao with a well-known technique to include the alternative video program in the digital information in order to increase efficiency of the communication system.

Regarding claim 68, Rao recites the system as discussed in the rejection of claim 60. Rao does not recite the digital information transmitted by the opportunistic programming means comprises computer data. Therefore, it would have been obvious one of the ordinary skill in the art at the time the invention was made to modify Rao with a well-known technique to include the computer data in the digital information in order to increase efficiency of the communication system.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Frezza (US 4,638,356) discloses apparatus and method for restricting access to a communication network.

Lightfoot (US 5,748,493) discloses level 1 gateway for video dial tone network.

Hendricks (US 5,600,364) discloses network controller for cable television delivery systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh
April 16, 2002


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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